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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/708,474 | 03/05/2004 | Cayetano Sanchez III | | 2473 |
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| 41480 | 7590 | 06/19/2006 |
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| EXAMINER |
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LEVINE, ADAM L

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| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/708,474 | SANCHEZ, CAYETANO | |
| | Examiner | Art Unit | |
| | Adam Levine | 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5 March 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the application filed March 5, 2004. Claims 1-10 are examined in this non-final office action.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 602.

It was not executed in accordance with either 37 CFR 1.66 or 1.68. The electronically filed declaration was not executed in accordance with 37 CFR 1.4(d)(3).

A new oath or declaration is required. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the

application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Drawings

The drawings are objected to under 37 CFR 1.84(h)(5) because Figure 1 show(s) modified forms of construction in the same view. The drawings are further objected to for the reasons indicated in the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claims 2-10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims are drawn to a system while the independent claim is drawn to a method. For purposes of this objection it is assumed the claims intended to refer to a system that can perform the method of claim 1, however, see the 112 and 101 rejections below. These claims are improper dependent claims because it would be possible to infringe these claims without infringing the claim from which they depend. A system that can perform the method would be infringing even if it were not in the process of performing the method.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 2-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject**

matter which applicant regards as the invention. The claims depend from claim 1 and refer to the invention of the independent claim as a system, but the independent claim is actually drawn to a method. Dependent claim 2 is also drawn to elements of a system (software and data resident on one or more computers) rather than a method, while other dependent claims that further depend from claim 2 are drawn to additional method steps. It therefore cannot be determined exactly what the claims intend to encompass and to what statutory class the invention belongs. Claim 6 is further rejected because the phrase, "in the clear," has not been defined in the specification and it cannot be determined exactly what property or step the phrase intends to encompass.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 2-10 are rejected under 35 U.S.C. 101 because the claims each attempt to claim two or more statutory classes of invention. The claims are therefore directed to neither a "system" nor a "method," but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Ex parte Lyell*, 17 USPQ2d 1548 at 1551 (Bd. Pat. App. & Inter. 1990).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claim 1-10 are rejected under 35 U.S.C. 102(a) as being anticipated by Yanagita (US Pub. No. 2003/0099459).

Yanagita teaches all the limitations of claims 1-10. For example, Yanagita discloses methods of facilitating transactions through the exchange of information, including validation data and configuration information, and of producing a picture program for distribution. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner. Yanagita further discloses:

- combining software with validation data and configuration information: such that each instance of said software, validation data, and configuration information can be used to conduct one or more online transactions (see at least figs.2-7, p.6

para.0075, 0081; p.14 para.0205,0208; p.28 para.0448, p.30 para.0463,0473;
p.32 para.0503, p.46 para.0686, p.58 para.0868).

- executing said software on a plurality of computers: exchanging said validation data, and exchanging said configuration information across a network with at least one other computer to validate said transactions (see at least figs.1,3-5; p.1 para.0008, p.3 para.0034,0038; p.4 para.0053, p.20 para.0334, p.23 para.0376,0381,0383; p.43 para.0638).
- using said validation data and said configuration information to manage said transactions: conducting said transactions to access services, and conducting said transactions to access products (see at least p.18 para.0309, p.19 para.0323,0328-0329; p.34 para.0528,0532; p.41 para.0612, p.48 para.0713, p.54 para.0809).
- client software and validation data that is resident on one or more computers: that can be used to transmit digital images, exchange validation data, and exchange configuration information to one or more image collection servers via a network connection for photo processing by one or more photo processing facilities (see at least figs.2,12-15; p.1 para.0006, p.29 para.0458, p.30 para.0463. Please note: the recitation that an element “can be used to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.); client software exchanges validation data and configuration information with one or more image collection servers for the purposes of validating one or more transactions or

identifying the photo processing services and products included in one or more transactions (see at least p.1 para.0001, 0006-0007; p.2 para.0021, p.16 para.0283, p.18 para.0308-0309; p.19 para.0321-0323); digital images are securely transmitted, transmitted in the clear, to one or more image collection servers as part of one or more transactions (see at least p.2 para.0016, p.18 para.0315, p.19 para.0321, p.43 para.0637); one or more image collection servers manages one or more transactions for client software using the validation data and configuration information data (see at least p.19 para.0321, 0330; p.20 para.0335-0336; p.31 para.0490, p.35 para.0548); validation data is unique for each instance of client software produced (see at least p.23 para.0383, p.28 para.0448), validation data is not unique (see at least figs.2-7, 12-15; p.1 para.0006, p.6 para.0075, 0081; p.14 para.0205,0208; p.29 para.0458, p.30 para.0463,0473; p.32 para.0503, p.46 para.0686, p.58 para.0868); validation data can be provided to the user of the software separately and be used in conjunction with the client software to manage the number or type of transactions available to an instance of client software for photo processing services and products (see at least figs.2-7, 12-15; p.1 para.0006, p.6 para.0075, 0081; p.14 para.0205,0208; p.29 para.0458, p.30 para.0463,0473; p.32 para.0503, p.46 para.0686, p.58 para.0868).

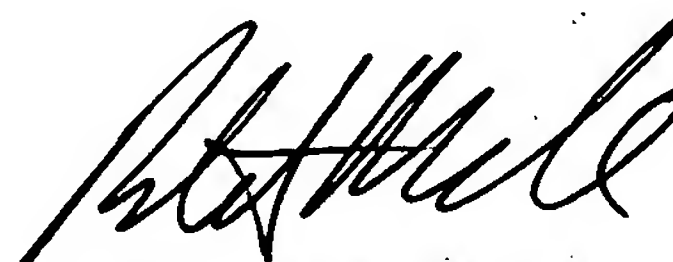
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert M. Pond can be reached on 571.272.6760. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
June 11, 2006


Robert M. Pond
Primary Examiner